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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,967	03/31/2004	Alison C. Swift	00565-073001	7704
26181	7590	07/07/2006		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
			EXAMINER ROBINSON, MARK A	
			ART UNIT 2872	PAPER NUMBER

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/815,967	Applicant(s) SWIFT ET AL.	
	Examiner Mark A. Robinson	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2-7 and 9-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,8,24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kephart (US 3401999).

As discussed previously, Kephart shows a microscope including a base(1), support arm(2), secondary stage height adjuster(83-89), head including a lens(7), eyepiece(5), and stage(8) which is releasably attachable to the support arm at a plurality of locations providing a plurality of working distances (note items 84,85; col. 3 lines 32-38), and when the stage is attached to the support arm, a working distance is further adjustable using the secondary stage height adjuster. Note that this adjuster includes a rack and pinion mechanism(83,88).

Kephart does not show an illuminator between the base and stage. However, such illuminators are well known in the art.

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It would have been obvious to the ordinarily skilled artisan at the time of invention to include such an illuminator in Kephart's microscope in order to enable illumination of the specimen under study. Since applicant has not traversed the examiner's statement of what was well known in the art, the object of this statement is taken to be admitted prior art.

Further, Kephart does not specifically disclose viewing at more than 45x with a working distance of 10mm or less, or viewing at less than 45x with a working distance of 10mm or more as in claim 1, or the further specified values in claims 24 and 25.

However, as noted above, Kephart discloses means for viewing over a wide range of working distances (col. 1 line 70), with said means being capable of adjustment via items 83-89 to working distances of more and less than 10mm as claimed. Further, the viewing magnification will be determined by the particular objective being used. Microscope objectives of various magnifications which are useable at working distances in the claimed range are well known in the art. Note the references cited herewith which provide examples of such objectives. Accordingly, it would have been obvious to the ordinarily skilled artisan at the time of invention to include well known objective lenses in the claimed range in order to

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enable viewing of the sample at different magnifications as is readily apparent to one of skill in the art.

Response to Arguments

3. Applicant's arguments filed 4/19/06 have been fully considered but they are not persuasive.

Applicant has argued that Kephart does not provide for both macroscopic and microscopic viewing.

However, the title of Kephart's invention is "MICROSCOPE" which implies viewing microscopic objects. Additionally, viewing of relatively large or "macroscopic" specimens is discussed throughout Kephart's specification (e.g. col. 1 line 46, col. 2 line 9, etc.). Indeed, one of the objects of Kephart's invention is to enable viewing of specimens within a wide range of sizes (col. 1 line 52) by making the device adjustable over a wide range of working distances (col. 1 line 70, the paragraph bridging col. 2-3, etc.). Thus, applicant's assertion that Kephart is not concerned with providing a wide range of working distances is seen to be incorrect. That Kephart provides a "nonprofessional microscope" does not negate the fact that his device is capable of viewing both large (i.e. macroscopic) and small (i.e. microscopic) objects.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Kvamme, Kojima, Watanabe, and Suzuki disclose examples of various types of objective lenses falling within the claimed magnification ranges and being useable at the claimed working distances.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

6/29/06


MARK A. ROBINSON
PRIMARY EXAMINER